

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

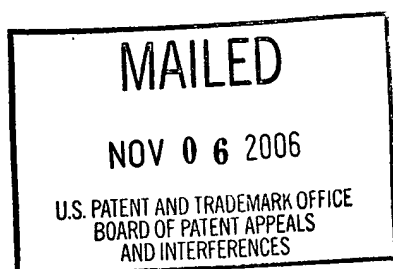
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KURTIS PAUL LONGNECKER,  
WALTER F. SCHMIDT, and JAMES ROSS STARK

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Appeal No. 2006-3076  
Application No. 10/004,948  
Technology Center 2100

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ON BRIEF

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Before THOMAS, JERRY SMITH, and DIXON, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 2, 5-9, 12-16, 19-23, and 26-36, which are all of the claims pending in this application. Claims 3, 4, 10, 11, 17, 18, 24, and 25 have been canceled.

We AFFIRM.

## BACKGROUND

The Appellants' invention relates to a universal server farm mass custom design tool. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for producing a drawing of components and connections needed to implement a desired system, the method comprising:

receiving user needs of the desired system, wherein the user needs describe specified capabilities and performance requirements of the desired system and do not provide schematic details for the desired system, and wherein the desired system is a computer network;

automatically determining components and connections needed to implement a system that satisfies the user needs based on the specified capabilities and performance requirements of the desired system and application of one or more system design rules to the specified capabilities [sic] and performance requirements of the desired system;

generating a drawing program input that provides instructions for producing a drawing of the system that satisfies the user needs using the determined components and connections to produce schematic details for the system; and

sending the drawing program input to a drawing program to generate a graphical output of the schematic details for the system.

## PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

O'Sullivan et al. (O'Sullivan)	2003/0065758 A1	April 3, 2003 (filed Sep. 28, 2001)
Flansburg et al. (Flansburg)	6,393,432	May 21, 2002 (filed Jun. 2, 1999)

## REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we make reference to the Examiner's answer (mailed December 21, 2005 ) for the reasoning in support of the rejection, and to Appellants' brief (filed Feb. 16, 2005 ) and reply brief (filed June 28, 2005) for the arguments thereagainst.

Claims 1, 2, 5, 7, 8, 9, 12, 14-16, 19, 21-23, 26, and 28-36 stand rejected under 35 U.S.C. § 102 as being anticipated by over O'Sullivan, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over O'Sullivan in view of Flansburg.<sup>1</sup>

Claims 6, 13, 20, and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Sullivan.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

At the outset, we note that Appellant has indicated three headings for three groupings for claims with respect to the first rejection and one heading for a single grouping with respect to the second rejection. We will address Appellants' arguments with respect to these four groupings.

From our review of the Examiner's rejection, we find that the Examiner has set forth a prima facie case of anticipation and in the alternative, a prima facie case of obviousness of the claimed invention as set forth in the Answer at pages 4-6. Therefore, we look to Appellants' brief for a persuasive argument as to error in the Examiner's prima facie cases.

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<sup>1</sup> We note that the paragraph setting forth the grounds of rejection does not include claims 29-36, but the body of the rejection includes a discussion of the basis for the rejection. Therefore, we will address these claims as being rejected.

**35 U.S.C. § 102**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. See Studiengesellschaft Kohle, m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the Appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

With respect to anticipation, Appellants argue that O'Sullivan does not receive the requirements for an "entire" computer network and that O'Sullivan does not show

generating and sending information to a drawing program, either internal or external (Brief, p. 13).

The Examiner maintains that O’Sullivan does teach receiving requirements for a computer network at [0027] with respect to flow requirements and that the claim language does not recite an “entire” computer network. We agree with the Examiner and find that the claim language only states a “computer network” and that the flow requirements disclosed by O’Sullivan would have been the user needs of the desired system, wherein the user needs describe specified capabilities and performance requirements (Answer, p. 7). Appellants provide a definition from Webopedia of computer network as a group of two or more computers systems linked together (Brief, p. 13). First, we find no date for the definition, and we do not find that the definition requires that the end units of the computer system not be previously designated. Appellants appear to desire that the claim language be interpreted as not having the end units of the computer system be in existence in the design or plan prior to implementation (Brief, p. 13). We find this interpretation of the claim language to be overly limited. We find no express or implied limitation that independent claim 1 requires that the interconnection fabric and the end units of the computer network be selected in the determining step. O’Sullivan teaches the determination of the network fabric and the components and connections therein which are used to meet the flow requirements. Therefore, Appellants’ argument is not persuasive.

With respect to Appellants’ argument that O’Sullivan does not show generating and sending information to a drawing program and that the Examiner can’t use what is generally known about design tools in place of what O’Sullivan expressly teaches (Brief, p. 13), we agree with Appellants, but find that O’Sullivan teaches the use of a Computer Aided Design (CAD) tool (O’Sullivan at [0027]) and that it would be used with a computer system as shown in Figure 1. From our review of Figure 1 and the on-screen cursor control 107 and the display device 105 and the disclosure in paragraph [0027] that a “designer is given a set of sources, or host computers; a set of targets, or storage

devices, and a set of required flows . . . interconnect fabric must be built to simultaneously support these flow requirements . . . the fabric . . . can be constructed.” We find these teachings to clearly show that the CAD-based system would have inherently had an interactive display which would have drawn the fabric as the processes completed portions of the design and during each recursion/iteration. To present the results to the designer, the CAD system would have had to have generated results and provided them to a drawing program. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection under anticipation of independent claim 1 and its dependent claims.

With respect to dependent claim 5, Appellants argue that O'Sullivan does not teach drawing with a drawing program (Brief, p. 15). As discussed above, with respect to independent claim 1, we find that O'Sullivan teaches a drawing program in the CAD system. Therefore, Appellants' argument is not persuasive, and we will sustain the rejections under anticipation and dependent claims 12, 19, and 26 which Appellants elected to group therewith.

### **35 U.S.C. § 103**

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5

USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. With respect to independent claim 1, Appellants argue that O’Sullivan did not meet three of the steps of the claimed limitations and that Flansburg “does not show how information regarding the requirements for a computer network is gathered or how the information to produce a drawing of the proposed computer network is collected and sent to the drawing program” (Brief, p. 15). We

disagree with Appellants and find that O'Sullivan teaches the input of the system requirements are input by the designer. Additionally, we find no express limitations in independent claim 1 as to "how" the information is gathered. Therefore, Appellants' argument is not persuasive.

With respect to "how the information to produce a drawing of the proposed computer network is collected and sent to the drawing program," again we find no express limitations in independent claim 1 as to "how the information to produce the drawing of the proposed computer network is collected and sent to a drawing program" (Brief, p. 15). Therefore, Appellants' argument is not persuasive. Furthermore, we do find that Flansburg clearly teaches in Figures 6 and 7 that the sketch documents are edited and forwarded to graphics program. Therefore, we find that Flansburg teaches that information to produce a drawing/display of the proposed computer network and communication fabric is collected and sent to the drawing program. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection under obviousness of independent claim 1 and its dependent claims.

With respect to dependent claim 5, Appellants argue that O'Sullivan does not teach drawing with a drawing program. As discussed above, with respect to independent claim 1, we find that O'Sullivan teaches a drawing program in the CAD system (Brief, p. 15). Furthermore, we find that Flansburg additionally teaches editing sketches which would involve a drawing program. Therefore, Appellants' argument is not persuasive, and we will sustain the rejections under obviousness of dependent claim 5 and dependent claims 12, 19, and 26 which Appellants elected to group therewith.

With respect to dependent claim 7, Appellants maintain that the agent performed a word search and did not find the words "policy", "policies," or a related word. We find this argument to be unpersuasive since it does not address the merits of the rejections set forth by the Examiner. The Examiner maintains that the feasibility test of O'Sullivan would have been a set of policies and the fact that connections are scored and ranked for selection is based on policies. We agree with the Examiner, and we find that Appellants have not made a persuasive showing as to why the Examiner's interpretation is unreasonable. Therefore, Appellants' argument is not persuasive.



Additionally, we find that O'Sullivan teaches that using flow-to-port assignment, these implementations use different criteria for deciding which flow to assign or even move a follow to a different assignment and that termination criteria can be different. Here, we find that these criteria are clearly policies that must be satisfied for proper functioning. Therefore, Appellants' argument is not persuasive, and we will sustain the rejections under anticipation and obviousness of dependent claim 7 and dependent claims 14, 21, and 28 which Appellants elected to group therewith.


With respect to dependent claim 6, Appellants' state that the claims stand or fall with the independent claims and have not set forth separate arguments for patentability. Since we did not find Appellants arguments with respect to independent claim 1 persuasive, we similarly do not find them persuasive with respect to dependent claim 6, and we will sustain the rejection under obviousness of dependent claim 6 and dependent claims 13, 20, and 27 which Appellants elected to group therewith.

#### CONCLUSION


To summarize, we affirm the rejections of claims 1, 2, 5-9, 12-16, 19-23, and 26-36 under 35 U.S.C. §§ 102 and 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

  
JAMES D. THOMAS  
Administrative Patent Judge

*Jerry Smith*  
JERRY SMITH  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

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Appeal No. 2006-3076  
Application No. 10/004,948

Page 11

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